IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Schroeder**	§	Group Art Unit: **2178**
Serial No.: **09/826,664**	§	Examiner: **Stork, Kyle R.**
Filed: **April 5, 2001**	§	Attorney Docket No.: **AUS920000850US1**
For: **Method, Apparatus, and Program for Creating Bookmark Symlinks**	§	

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

RESPONSE TO DECISION ON APPEAL

Sir:

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

In response to the Decision on Appeal of November 27, 2007, please reopen prosecution and amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 9 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Previously presented) A method in a data processing system for creating symbolic links to bookmarks, comprising:

receiving a request to create a new bookmark for a document;

in response to receiving the request, determining whether a reference bookmark already exists for the document;

if the reference bookmark for the document already exists, creating a symbolic link; and

linking the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.

2. (Previously presented) The method of claim 1, further comprising:

receiving a name for the symbolic link.

3. (Previously presented) The method of claim 1, further comprising:

receiving a description for the symbolic link.

4. (Previously presented) The method of claim 1, wherein the step of linking the symbolic link to the already existing reference bookmark comprises storing a pointer to the already existing reference bookmark in the symbolic link.

5. (Original) The method of claim 1, wherein each bookmark includes a uniform resource locator for the document.

6. (Original) The method of claim 5, wherein the step of determining whether a reference bookmark already exists for the document comprises comparing the uniform resource locator of the bookmark to the uniform resource locator of each existing bookmark.

7. (Previously presented) The method of claim 1, further comprising:

if the reference bookmark for the document already exists, prompting a user whether to create the symbolic link.

8. (Previously presented) The method of claim 7, wherein the step of creating the symbolic link comprises creating the symbolic link in response to a user's request to create the symbolic link.

9. (Previously presented) A method in a data processing system for creating symbolic links to bookmarks, comprising:

receiving a request to create a symbolic link for a document to an already existing reference bookmark;

in response to receiving the request, identifying the already existing reference bookmark;

creating the symbolic link to the already existing bookmark; and

linking the symbolic link to the already existing reference bookmark.

10. (Previously presented) The method of claim 9, wherein the step of identifying the already existing reference bookmark comprises:

presenting at least one existing bookmark;

receiving a selection of a reference bookmark from the at least one existing bookmark;

11. (Original) The method of claim 10, wherein the step of presenting at least one existing bookmark comprises presenting the at least one existing bookmark in a tree structure.

12. (Original) The method of claim 11, wherein the step of receiving a selection of a reference bookmark comprises receiving the selection of the reference bookmark in the tree structure.

13. (Previously presented) The method of claim 11, further comprising:

displaying a symbolic representation of the symbolic link in the tree structure.

14. (Previously presented) The method of claim 13, wherein modifications to the reference bookmark are displayed in relation to the symbolic representation of the symbolic link in the tree structure.

15. (Original) The method of claim 9, wherein each bookmark includes a uniform resource locator for the document.

16. (Original) The method of claim 15, wherein the step of identifying a reference bookmark comprises:

determining whether a bookmark already exists for the document.

17. (Original) The method of claim 16, wherein the step of determining whether a bookmark already exists for the document comprises comparing the uniform resource locator of the bookmark to the uniform resource locator of each existing bookmark.

18. (Previously presented) The method of claim 16, further comprising:

if the reference bookmark for the document already exists, prompting a user whether to create the symbolic link.

19. (Previously presented) The method of claim 18, wherein the step of creating the symbolic link comprises creating the bookmark link in response to the user's request to create the symbolic link.

20. (Previously presented) The method of claim 9, wherein the step of linking the symbolic link to the reference bookmark comprises storing a pointer to the already existing reference bookmark in the symbolic link.

21. (Previously presented) A method in a data processing system for creating a plurality of symbolic links to bookmark folders from a single reference bookmark folder, comprising:

receiving a request to create a symbolic folder link to an already existing reference bookmark folder;

in response to receiving the request, identifying the already existing reference bookmark folder;

creating the symbolic folder link to the already existing bookmark folder; and

linking the symbolic folder link to the already existing reference bookmark folder.

22. (Currently amended) The method of claim 21, wherein the step of identifying the already existing reference bookmark folder comprises:

presenting at least one existing bookmark folder; and

receiving a selection of a reference bookmark folder from the at least one existing bookmark folder[[;]].

23. (Original) The method of claim 22, wherein the step of presenting at least one existing bookmark folder comprises presenting the at least one existing bookmark folder in a tree structure.

24. (Original) The method of claim 23, wherein the step of receiving a selection of a reference bookmark folder comprises receiving the selection of the reference bookmark folder in the tree structure.

25. (Previously presented) The method of claim 23, further comprising:
displaying a symbolic representation of the symbolic folder link in the tree structure.

26. (Previously presented) The method of claim 25, wherein bookmarks added to the reference bookmark folder are displayed in relation to the symbolic representation of the symbolic folder link in the tree structure.

27. (Previously presented) The method of claim 21, further comprising:
receiving a name for the symbolic folder link.

28. (Previously presented) The method of claim 21, further comprising:
receiving a description for the symbolic folder link.

29. (Previously presented) The method of claim 21, wherein the step of linking the symbolic folder link to the already existing reference bookmark folder comprises storing a pointer to the reference bookmark folder in the symbolic folder link.

30. (Previously presented) An apparatus for creating symbolic links to bookmarks, comprising:
at least one existing bookmark; and
a bookmark editor that receives a request to create a new bookmark for a document, determines whether a reference bookmark already exists for the document within the at least one existing bookmark in response to receiving the request, creates a symbolic link if the reference bookmark for the document already exists, and links the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.

31. (Previously presented) The apparatus of claim 30, wherein the bookmark editor links the symbolic link to the already existing reference bookmark by storing a pointer to the already existing reference bookmark in the symbolic link.

32. (Original) The apparatus of claim 30, wherein each bookmark includes a uniform resource locator for the document.

33. (Original) The apparatus of claim 32, wherein the bookmark editor determines whether a reference bookmark already exists for the document by comparing the uniform resource locator of the bookmark to the uniform resource locator of each existing bookmark.

34. (Previously presented) The apparatus of claim 30, wherein the bookmark editor prompts a user whether to create the symbolic link if the reference bookmark for the document already exists.

35. (Previously presented) The apparatus of claim 34, wherein the bookmark editor creates the symbolic link in response to a user's request to create the symbolic link.

36. (Previously presented) An apparatus for creating a plurality of symbolic links to bookmarks from a single reference bookmark, comprising:

at least one existing bookmark; and

a bookmark editor that receives a request to create a symbolic link to an already existing reference bookmark, identifies the already existing reference bookmark within the at least one existing bookmark in response to receiving the request, creates the symbolic link to the already existing bookmark, and links the symbolic link to the already existing reference bookmark.

37. (Previously presented) The apparatus of claim 36, wherein the bookmark editor identifies the already existing reference bookmark by presenting the at least one existing bookmark and receiving a selection of the reference bookmark from the at least one existing bookmark.

38. (Original) The apparatus of claim 37, wherein the bookmark editor presents the at least one existing bookmark in a tree structure.

39. (Original) The apparatus of claim 38, wherein the bookmark editor receives the selection of the reference bookmark in the tree structure.

40. (Previously presented) The apparatus of claim 38, wherein the bookmark editor displays a symbolic representation of the symbolic link in the tree structure.

41. (Previously presented) An apparatus for creating a plurality of symbolic links to bookmark folders from a single reference bookmark folder, comprising:

at least one existing bookmark folder; and

a bookmark editor that receives a request to create a symbolic folder link to an already existing reference bookmark folder, identifies the already existing reference bookmark folder within the at least one existing bookmark folder in response to receiving the request, creates the symbolic folder link to the already existing bookmark folder, and links the symbolic folder link to the already existing reference bookmark folder.

42. (Previously presented) The apparatus of claim 41, wherein the bookmark editor identifies the already existing reference bookmark folder by presenting the at least one existing bookmark folder and receiving a selection of the reference bookmark folder from the at least one existing bookmark folder.

43. (Original) The apparatus of claim 42, wherein the bookmark editor presents the at least one existing bookmark folder in a tree structure.

44. (Original) The apparatus of claim 43, wherein the bookmark editor receives the selection of the reference bookmark folder in the tree structure.

45. (Previously presented) The apparatus of claim 43, wherein the bookmark editor displays a symbolic representation of the symbolic folder link in the tree structure.

46. (Previously presented) The apparatus of claim 45, wherein bookmarks added to the reference bookmark folder are displayed in relation to the symbolic representation of the symbolic folder link in the tree structure.

47. (Currently amended) A computer program product, comprising [[in]] a computer ~~readable~~ recordable-type medium[[,]] storing computer readable program code for creating symbolic links to bookmarks, the computer program product comprising:

instructions for receiving a request to create a new bookmark for a document;

in response to receiving the request, instructions for determining whether a reference bookmark already exists for the document;

instructions for creating a symbolic link if the reference bookmark for the document already exists; and

instructions for linking the symbolic link to the already existing reference bookmark, wherein a new bookmark is not created.

48. (Currently amended) A computer program product, comprising [[in]] a computer ~~readable~~ recordable-type medium[[,]] storing computer readable program code for creating symbolic links to bookmarks, the computer program product comprising:

instructions for receiving a request to create a symbolic link for a document to an already existing reference bookmark;

in response to receiving the request, instructions for identifying the already existing reference bookmark;

instructions for creating the symbolic link to the already existing bookmark; and

instructions for linking the symbolic link to the already existing reference bookmark.

49. (Currently amended) A computer program product, comprising [[in]] a computer ~~readable~~ recordable-type medium[[,]] storing computer readable program code for creating a plurality of symbolic links to bookmark folders from a single reference bookmark folder, the computer program product comprising:

instructions for receiving a request to create a symbolic folder link to an already existing reference bookmark folder;

in response to receiving the request, instructions for identifying the already existing reference bookmark folder;

instructions for creating the symbolic folder link to the already existing bookmark folder; and

instructions for linking the symbolic folder link to the already existing reference bookmark folder.

REMARKS/ARGUMENTS

Claims 1-49 are pending in the present application. Claims 22, and 47-49 were amended. Support for the amendments to claims 47-49 can be found, for example, on page 14, line 26 to page 15, line 12 of the specification. Claim 22 was amended to correct typographical errors. Reconsideration of the claims is respectfully requested in view of the above amendments and the following comments.

I. 35 U.S.C. § 101

In the Decision on Appeal issued by the Board of Patent Appeals and Interferences on November 27, 2007, the Board issued a "NEW GROUND OF REJECTION" pursuant to 37 C.F.R. § 41.50(b) rejecting claims 47-49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Pursuant to the Board's Decision, Applicants respectfully request that prosecution of this application be reopened for reconsideration by the Examiner.

In rejecting claims 47-49, the Board stated:

> In addition to reversing the Examiner's rejection of claims 1-49, this decision, pursuant to our authority under 37 C.F.R. § 41.50(b), contains a new ground of rejection.
>
> Claims 47-49 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 47 reproduced *supra*, is representative.
>
> Specifically, claim 47 is directed to "[a] computer program product, in a computer readable medium . . ." and Appellant explicitly discloses that "computer-readable media include . . . transmission-type media, such as digital and analog communications links . . ."(FF 3).
>
> We find that Appellant's description of a 'computer readable media' implicates intangible signals despite the absence of such term in the description.
>
> That said, the issue, quite simply, is whether a claimed computer readable media that is broad enough to include transmission-type media - a media that includes intangible signals - is statutory subject matter. The Federal Circuit recently held that an intangible signal is not statutory subject matter because it does not fall within any of the four categories of statutory subject matter. *See In re Nuijten,* 500 F.3d 1346, 1357 (Fed. Cir. 2007). In this instance, claim 47 includes both statutory subject matter (signals stored on a tangible medium) and non-statutory subject matter (intangible signals in a transmission medium). According to recent proposed USPTO interim guidelines, it must be amended to recite solely statutory subject matter.[3]
>
> Even if an intangible signal could be considered to be an article of manufacture, however, we find that such a signal does not operate as the claimed computer readable media. Claim 47, for example, recites a computer readable medium having instructions for causing a computer to execute a method. As a result, it is our view that the computer cannot perform the claimed functions while the instructions are within a carrier wave or a signal. In other words, the information, while in the transmission medium, is unavailable to the computer for performing the functions recited in claim 47.

> For the above reasons, we find that claims 47-49 recite non-statutory subject matter. The "medium" of claims 48 and 49 share the same interpretations as discussed *supra* for "medium" in claim 47. For the reasons *supra*, we conclude that claims 48 and 49 are also directed to nonstatutory subject matter.

Decision on Appeal dated November 27, 2007, pages 10-12.

By the present Amendment, claims 47-49 have each been amended to positively recite that the claims are directed to a computer program product that comprises a recordable-type medium storing computer readable program code. Such language is fully supported by the specification and excludes intangible signals in a transmission-type media. Applicants respectfully submit that claims 47-49 as amended herein fully satisfy the requirements of 35 U.S.C. § 101 in all respects, and withdrawal of the new ground of rejection issued by the Board of Patent Appeals and Interferences is respectfully requested.

II. Conclusion

For at least all the above reasons, claims 47-49, as amended herein, fully satisfy the requirements of 35. U.S.C. § 101 and this application is believed to be in condition for allowance. It is, accordingly, respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: January 22, 2008

Respectfully submitted,

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